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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/213,169 | 12/17/1998 | JOHN R. FREDLUND | 78685F-P | 7343 |

1333 7590 03/11/2004

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

FRIDIE JR, WILLMON

| ART UNIT | PAPER NUMBER |
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3722

DATE MAILED: 03/11/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/213,169
Filing Date: December 17, 1998
Appellant(s): FREDLUND ET AL.

Frank Pincelli
For Appellant

MAILED
MAR 11 2004
GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/19/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because

Group I should consist of claims 1,13,25,40,52

Group II-claims 2 and 3

Art Unit: 3722

Group III-claims 14.15

Group IV-claim26.

Group V- claim 53.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|---------|---------------|--------|
| 5791692 | Manico et al. | 8-1998 |
| 5764870 | Manico et al. | 6-1998 |
| 4903068 | Shiota | 2-1990 |
| 5782349 | Combs | 7-1998 |
| 5709496 | Werner et al. | 1-1998 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,7,12,13,19,23-25,29,34,35,40,43,44,46,50-52,57,58,62 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al. ('692) in view of Shiota.

Manico et al. Discloses an album leaf comprising a plurality of images (15-19 and 21-25), first and second sides (12,14) having a retaining means for holding the memory images and a plurality of openings (28). Manico et al lacks the disclosure of first and

Art Unit: 3722

second icons for identifying first and second sources of the memory images on the photographic sheets.

Shiota discloses a photographic sheet comprising an icon (64) with an image ID (65) inside the silhouette (60a,61a). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico et al. With an identifying icon with identification numbers which correspond to the images on the album leaf as taught by Shiota in order to categorize the content and provide more information on the images. To provide a second icon would have been obvious to a skilled artisan, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V Bemis Co.*, 193USPQ8.

Claims 2-6,14-18,26-28,30,36,41-45 and 53-56 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Manico in view of Shiota as applied to claims above, and further in view of Manico et al.('870).

Manico et al. As modified by Shiota discloses the claimed invention except for an origination ID being associated with at least one of the plurality of images which indicates the first source. Manico et al.('870) teaches that it is well known in the art to use a photographic sheet comprising an origination ID.. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico et al. As modified by Shiota with an origination ID inside the silhouette as taught Manico et al ('870) to indicate the identification images and the location of the images on the photographic sheet.

Art Unit: 3722

Claims 8,20,31,37 and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Manico ('692) in view of Shiota as applied to claims above, and further in view of Werner.

Manico ('692) as modified by Shiota discloses the claimed invention except for a film cartridge containing a strip of photographic film wherein the cartridge has an ID number. Werner teaches that it is well known in the art to use an apparatus for storing a film cartridge (23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico ('692) as modified by Shiota with a film cartridge on a photographic sheet in the manner as taught by Werner et al so that the film cartridge can be kept together with corresponding images for later use. Further, Official Notice is taken of the use of ID numbers on a film cartridge. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use ID numbers on a film cartridge since the use of such is old and well known in the art.

Claims 9,10,21,22,32,33,48,49,60 and 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Manico ('692) in view of Shiota as applied to claims above, and further in view of Combs.

Combs disclose a CD ROM holder comprising a CD ROM (10) on the photographic sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico ('692) as modified by Shiota with a CD Rom and holder in order to increase the storage capacity of the assembly. Further, Official Notice is taken of the use of ID numbers on a CD ROM holder. It would have been obvious to one having ordinary skill in the art at the time the invention was made

Art Unit: 3722

to use ID numbers on a CD ROM holder since the use of such is old and well known in the art.

(11) *Response to Argument*

Appellant argues that in independent claims 1,40,52 that the claimed icons provide information for individually identifying the source from which the images on the leaf originate and that neither Manico ('492) or Shiota teach such icons. The examiner submits that Shiota discloses a photographic sheet comprising an icon (64) with an image ID (65) inside the silhouette (60a ,61a) which clearly constitutes an identifying element. Shiota states at column 5, lines 46-50 that "After printing of all frames of the color negative film 11, the inlaid arrangement of component images of an inlaid composite image with frame numbers 65 are displayed on the color monitor for visual inspection". Hence the frame numbers inherently provide an identifying icon which represents the location/source of the images on the negative film and meets the limitations in the claims as broadly presented. Further it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico et al. With an identifying icon with identification numbers which correspond to the images on the album leaf as taught by Shiota in order to categorize the content and provide more information on the images.

Art Unit: 3722

In response to appellants argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the present case, the cited patent Manico ('692) is almost a carbon copy of the claimed invention and only lacks the disclosure of the identifying icons. Also Shiota is deemed to be analogous art, since it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Shiota clearly meets this criteria as evidenced by its disclosure of photographic images on a leaf structure and identifying icons.

In regard to appellant's argument on page 5, paragraph one of his brief that there is no teaching or suggestion of providing an icon in the form of a silhouette as taught and claimed by appellant in either above mentioned reference, the examiner submits that Shiota inherently provides silhouettes in its reduced images in the 4x4 matrix print icon 64

For the above reasons, it is believed that the rejections should be sustained.


Art Unit: 3722

Respectfully submitted,



Willmon Fridie, Jr.
March 8, 2004

Conferees



Andra Wellington, SPE

Allan Shoap, SPE 

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201